

**REMARKS****Status of the Claims**

Upon entry of the amendment above, claims 1-23 will be pending, claims 1 and 14 being independent.

**Summary of the Office Action**

Claims 1, 3-5, and 9 are rejected under 35 USC §102(b) as being anticipated by WO 98/37782 (hereinafter "WO '782").

Claims 1, 3-5, and 9 are rejected under 35 USC §102(b) as being anticipated by BASSO et al. (U.S. Patent No. 6,405,457, hereinafter "BASSO").

Claims 6 and 8 are rejected under 35 USC §103(a) as being unpatentable over WO '782.

Claims 6 and 8 are rejected under 35 USC §103(a) as being unpatentable over BASSO in view of BARRET (U.S. Patent No. 5,940,990).

Claim 2 is rejected under 35 USC §103(a) as being unpatentable over WO '782 or BASSO in view of MACCANO (U.S. Patent No. 4,822,500).

**Response to the Office Action****A. Summary of the Invention**

Before discussing the rejections, Applicants summarize their invention, citing reference numerals used in their drawings of two non-limiting embodiments.

The boot of the invention is directed to a boot (1, 80) that includes a sole (2, 81) and an upper (3, 82), the boot (1, 80) extending longitudinally between a heel (4, 83) and a tip, or toe (5, 84). The upper (3, 82) of the boot includes an outer envelope (12, 90) and an inner envelope (13, 91). In the embodiment shown in Figs. 4 and 5, the inner envelope (91) is removably mounted within the outer envelope, *i.e.*, in the

form of a boot liner, whereas, in the embodiment of Figs. 1-3, the base (43) of the inner envelope (13) is fixed to the base (25) of the outer envelope (12), as well as to the sole (2) and, therefore, the inner envelope/liner in Figs. 1-3 is not removable in the sense of that of the embodiment of Figs. 4 and 5.

In both embodiments, the boot includes a mechanism for tightening the *inner envelope* (13, 91), which mechanism includes at least one lace (54, 102) and at least one keeper (60, 104), with the at least one keeper being affixed to the *outer envelope* in the area of the heel (4, 83) of the boot. In the illustrated embodiments, the at least one keeper (60, 104) is affixed to an inner surface of the outer envelope.

In prior art boots that include liners, or inner envelopes, having a lace and tightening mechanism, there tends to be a relative movement between the inner and outer envelopes, since the inner tightening mechanism is not fixed to the outer envelope and, importantly, there is no keeper in the area of the heel of the outer envelope to restrain such relative movement.

#### **B. Summary of the Amendment**

In the amendment above, independent claim 1 has been amended, as have dependent claims 4 and 5. New claims 11-23 have been added, of which claim 14 is independent. In addition, paragraphs 0056 and 0067 have been amended to specify that the rear keepers in the two illustrated embodiments are affixed to an inner surface of the outer envelope. No prohibited new matter has been added by amendment.

#### **C. Withdrawal of Rejections Under 35 USC §§102, 103 Based Upon WO '782**

At least for the following reasons, Applicants request that the rejections based

upon WO '782, alone or in combination with other documents, and whether for anticipation or obviousness, be withdrawn.

WO '782 discloses a boot having a mechanism for tightening an inner envelope 14, such mechanism including keepers 22, 24 affixed to the inner envelope 14 and a lace 20.

A distinction between the invention and the boot of WO '782 is the arrangement of the keeper(s) on the outer envelope.

In the invention, each keeper (60, 104) receiving a lace (54, 102) is located substantially in the area of the heel 4, 83 of the boot. Very differently, in WO '782, the keepers 18 receiving the lace 20 on the outer envelope are located along each side of the opening 16 in the shell 12. The opening 16 runs approximately between the metatarsus and the instep, in an area above the foot. Accordingly, in WO '782, the keepers are not located in an area of the heel.

At least for this reason, reconsideration and withdrawal of all rejections that are based solely or in part upon WO '782.

With regard to the rejection of various dependent claims, Applicants respectfully submit that, in spite of the fact that WO '782 discloses folded straps 22 (on the inner envelope), WO '782 nevertheless fails to teach or suggest a rear keeper in the form of a folded strap portion *in the form of a V-shaped loop*, as specified in Applicants' claim 8 (and as shown, for example, in Figs. 1 and 4, and as described in paragraph 0057).

Further, Applicants note that the outer envelope of WO '782 is a substantially rigid outer shell 12 (see page 4, lines 25-27). One skilled in the art would recognize that it is quite easy to make a hole in the shell 12 for the purpose of making keepers

18, but that it would be increasingly more difficult to affix loops onto the shell 12. Affixing loops would require several additional parts and, more difficult, affixing them onto the shell 12. Sewing would be difficult and complicated and gluing might not be easy and/or reliable.

Lastly, regarding MACCANO, a sling member 40 is disclosed, which is comparatively very short compared to that of an insole, which conventionally runs from the heel to the tip of a boot, and, therefore, MACCANO's sling is quite different from what one skilled in the art would recognize as an insole. Accordingly, Applicants submit that one skilled in the art would not have been motivated to have modified the boot of WO '782 in a way that would have resulted in the invention specified in Applicants' claim 2.

**D. Withdrawal of Rejections Under 35 USC §§102, 103 Based Upon BASSO**

At least for the following reasons, Applicants request that the rejections based upon BASSO, alone or in combination with other documents, and whether for anticipation or obviousness, be withdrawn.

BASSO discloses a boot the upper of which comprises an outer envelope 10 and an inner envelope 20. The boot of BASSO includes a mechanism for tightening the inner envelope 20, the mechanism including keepers 25 affixed to the inner envelope 20 and a lace 26.

A distinction between the invention and the boot of BASSO is the arrangement of the keeper(s) on the outer envelope.

In the invention, the boot includes keepers 60, 104 which receive a lace 54, 102 substantially in the area of the heel 4, 83 of the boot on the outer envelope 12, 90. Very differently, in BASSO, the keepers 55, which are not located on the inner

envelope 20, are on a removable reinforcing element 30. These keepers are not at all on the outer envelope 10.

At least for this reason, reconsideration and withdrawal of all rejections that are based solely or in part upon BASSO.

With regard to the rejection of certain dependent claims based upon a combination of BASSO and BARRET, the drawing figures of BASSO show that the tightening mechanism always includes at least one hook. In the same spirit, the drawing figures of BARRET show the tightening mechanism of the outer envelope always includes rigid rings. In view of the foregoing, Applicants respectfully submit that one skilled in the art would not have been motivated to have made a tightening mechanism that would include loops. In addition, BASSO fails to teach or suggest a rear keeper in the form of a folded strap portion *in the form of a V-shaped loop*, as specified in Applicants' claim 8 (and as shown, for example, in Figs. 1 and 4, and as described in paragraph 0057).

Lastly, Applicants' comments regarding MACCANO, in connection with the purported combination with WO '782, are applicable to the combination with BASSO.

**E. New Claims 10-23**

In the amendment above, new claims 10-23 have been added.

New dependent claim 10 further emphasizes that the boot of claim 1 has at least one rear keeper that is affixed to the outer envelope in the area of the heel of the boot. This is not taught or suggested by WO '782 or BASSO, nor the combinations based thereupon.

New dependent claim 11 more specifically refers to the at least one rear keeper being affixed to an *inner surface of the outer envelope* in the area of the heel of the

boot.

New dependent claim 12 specifically refers to the outer envelope as being relatively flexible for facilitating walking and inclinations of a wearer's lower leg. WO '782 includes a rigid shell and BASSO uses a reinforcing element.

New dependent claim 13 specifies that the outer envelope is affixed to the external sole by means of an adhesive and/or stitching. The reinforcing element of BASSO is not so affixed.

New independent claim 14 is specifically directed to a *snowboard boot* that includes, among other limitations, an outer envelope affixed to an external sole and having a flexibility for facilitating walking when not mounted on a snowboard and for facilitating inclinations of the upper while steering a snowboard, as well as a mechanism for both retaining a wearer's foot with respect to the inner envelope and retaining the wearer's foot with respect to the outer envelope. Such mechanism includes at least one rear keeper affixed to the outer envelope substantially in an area of the heel of the boot, with a lace extending through the rear keeper as well as through a plurality of the keepers affixed to the inner envelope.

As mentioned above, neither WO '782 nor BASSO includes a tightening mechanism with rear keepers positioned as recited in claim 14, particularly in the area of the heel of the boot.

New dependent claim 15 specifies that the inner envelope is a removable liner not glued or stitched within the snowboard boot.

New dependent claim 16 specifies two rear keepers, one of which is located on a lateral side on a lateral quarter of the outer envelope and another of which is located on a medial side on a medial quarter of the outer envelope.

New dependent claim 17 specifies that the keepers affixed to the inner envelope and the at least one rear keeper affixed to the outer envelope are loops associated with the inner envelope and the outer envelope, respectively.

Still further, claim 18, which depends from claim 17, specifies that the loops of the keepers comprise folded strap portions affixed to the outer envelope substantially in the area of the heel of the boot.

New dependent claim 19 specifies that the rear keeper is a folded strap portion to form a loop, the portion being V-shaped, the portion being formed of first and second strands, the first strand being affixed to the outer envelope slightly forward of the heel, the second strand being affixed to the outer envelope slightly above the heel.

New dependent claim 20 specifies that the upper includes a lower portion provided to surround the wearer's foot, and an upper portion provided to surround a portion of the wearer's lower leg.

New claim 21 depends from claim 14 and calls for both the inner and the outer envelopes of the upper to include respective lower portions to surround the wearer's foot and respective upper portions to surround a portion of the wearer's lower leg, and for the keepers, which are affixed to the inner envelope, to comprise a plurality of keepers affixed to the upper portion of the inner envelope and a plurality of keepers affixed to the lower portion of the inner envelope.

New claim 22 calls for the at least one rear keeper to be affixed to an inner surface of the outer envelope in the area of the heel of the boot.

Finally, new claim 23 specifies that the outer envelope is affixed to the external sole by means of an adhesive and/or stitching.

**SUMMARY AND CONCLUSION**

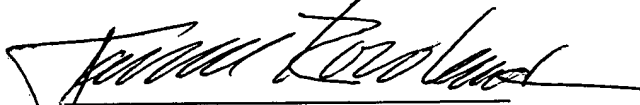
The grounds of rejection advanced in the Office action have been addressed and are believed to be overcome. Reconsideration and allowance are respectfully requested in view of the amendment and remarks above.

No fee is believed to be due at this time. However, the Commissioner is authorized to charge any fee required for acceptance of this reply as timely and complete to Deposit Account No. 19-0089.

Further, although no extension of time is believed to be necessary at this time, if it were to be found that an extension of time were necessary to render this reply timely and/or complete, Applicants request an extension of time under 37 CFR §1.136(a) in the necessary increment(s) of month(s) to render this reply timely and/or complete and the Commissioner is authorized to charge any necessary extension of time fee under 37 CFR §1.17 to Deposit Account No. 19-0089.

Any comments or questions concerning this application can be directed to the undersigned at the telephone or fax number given below.

Respectfully submitted,  
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